

REMARKS

In view of the following remarks, the Examiner is requested to allow claims 1-11, 22-28 and 36-38, the only claims pending and under examination in this application.

The Examiner is thanked for the indication that the following rejections have been withdrawn:

1. The rejections of claims 13, 16 and 18 under 35 U.S.C. § 103(a) over Harris, in view of Rava, in view of Ambrose; and
2. The rejections of claims 14-15, 17 and 19-21 under 35 U.S.C. § 103(a) over Harris, in view of Rava, in view of Ambrose, in further view of Besemer.

Claim Rejections – 35 U.S.C. §§ 102 and 103

General discussion regarding rejections based on Cattell

The claims of this case (e.g., claims 1-11, 22-28 and 36-38), require that feature characteristics are extracted from data obtained from a first array while a second chemical array is being read.

The Office Action presents several rejections (under both §102 and §103) that cite a conference abstract presented in 2000 by Herbert Cattell (hereinafter “the Cattell abstract”). The Cattell abstract discusses an array scanner system that “allows the user to load a carousel with arrays and ‘walkaway’ from the system, which is left to scan and feature extract unattended in a pipelined fashion.”

The Examiner relies upon the Cattell abstract for disclosing a scanner system that extracts data obtained from a first array while a second chemical array is being read. Office Action, page 3, lines 24-26. Furthermore, to support an alternative interpretation of the term “pipelined” that allegedly supports the rejections, the Examiner provides a very informal definition of the verb “pipeline” obtained from www.geek.com on May 21, 2007.

Initially, the Applicants note that, despite the Examiner’s attempted assertion that the www.geek.com reference was cited to show the inherent properties of the Cattell device, the Cattell abstract is actually only being used to explain the meaning of a term used in the primary reference. As such, MPEP § 2131.01(II) applies.

The Applicants further note that MPEP § 2131.01(II) explicitly states that extrinsic evidence can be taken into consideration if it shows the meaning of a term used in a cited reference.¹ Moreover, consistent with the relevant case law discussed in the MPEP that addresses this subject², it is axiomatic that the extrinsic evidence must show the meaning of a term at the time cited reference was written.

In this case, we believe that the Examiner has erred in that he has not provided any evidence that the www.geek.com definition from May 21, 2007, bears any relation to the meaning of “pipelined” in the Cattell abstract, which is dated over six years earlier (September 12, 2000). It is not even clear to the Applicants if the www.geek.com website actually existed in September 2000, whether the definition cited by the Examiner was available at that website if it did exist at that time, or whether the definition is indeed reliable.

In other words, the www.geek.com definition of May 21, 2007 (which is extrinsic evidence in that it is believed to explain the meaning of a term in Cattell’s abstract) cannot provide meaning of a term at the time Cattell abstract was written because it is not clear if that definition existed in 2000.

Thus, the sole piece of evidence cited by the Examiner to support an allegedly alternative interpretation of the term “pipelined” in the Cattell abstract lacks weight.

These rejections should be withdrawn for this reason alone.

Notwithstanding the above, even if the Examiner was using the www.geek.com reference to show the alleged inherent properties of the Catell device, the www.geek.com reference is insufficient to establish such inherency.

As explained by the MPEP, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.³ Furthermore, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

¹ MPEP § 2131.01(II) is explicitly clear: Extra References or Other Evidence Can Be Used to Show Meaning of a Term Used in the Primary Reference.

² *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991).

³ MPEP § 2112(IV), citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Here, the Applicants and the Examiner both agree that the Cattell abstract does not explicitly mention a scanner system that extracts data obtained from a first array while a second chemical array is being read.⁴ As best understood by the Applicants, the Examiner's position hinges on the interpretation of the word "pipelined" in the Cattell abstract (i.e., as it appears in the phrase ". . . the system, which is left to scan and feature extract unattended in a pipelined fashion.>").

The Applicants initially note that term "pipeline", as used as a verb, e.g., in the phrase "to pipeline information" appears to be jargon. However, given the analogy to water or oil flowing down a pipeline, the plain meaning of the term in the context of Cattell's abstract is clear: the term "pipelined" refers to a process through which data is processed as if the data is traveling down a pipeline. By analogy to a pipeline, Cattell's system is therefore one that processes data using "one after the other" methods. Such methods are *sequential*. As such, the Applicants believe that a fair reading of the Cattell abstract indicates that scanning and feature extraction occur one after the other (i.e., *sequentially*) rather than simultaneously, as would be required by the rejected claims.

Consequently, the Examiner's alleged alternative interpretation of the term "pipelined" in the Cattell abstract does not necessarily flow from the alleged teachings of the applied prior art. Therefore, the www.geek.com reference is insufficient to establish any inherent properties of the Cattell device. As such, these rejections may be withdrawn.

Finally, the Applicants note that a closer inspection the www.geek.com definition reveals that the pipelining only occurs in processors that have "two or more instruction pipelines". The Cattell abstract is silent on whether the processor used in Cattell's system contained a single instruction pipeline or more than one instruction pipeline. As such, even if the www.geek.com definition could be used to support the Examiner's interpretation of the word "pipelined" can mean "simultaneously processed", Cattell's abstract still cannot render the claims unpatentable because Cattell's system may have used a processor with a single instruction pipeline, rather than a processor with multiple instruction pipelines.

⁴ See Office Action dated May 30, 2007, bottom of page 3: "While Cattell et al do not explicitly state the simultaneity of the reading and extracting data . . ."

Since all the rejections of the instant Office Action rely on what appears to be an erroneous interpretation of the word “pipelined” in the Cattell abstract, it is believed that all rejections have been adequately addressed by the discussion above.

In view of the foregoing discussion, withdrawal of the following rejections is requested:

1. The rejection of claims 1, 3-4 and 11 under 35 U.S.C. § 102(b) over Cattell;
2. The rejection of claims 36-38 under 35 U.S.C. § 103(a) over Cattell, in view of Kallioniemi;
3. The rejection of claims 5-9 under 35 U.S.C. § 103(a) over Cattell, in view of Besemer;
4. The rejection of claims 22 and 23 under 35 U.S.C. § 103(a) over Cattell, in view of Ambrose;
5. The rejection of claim 10 under 35 U.S.C. § 103(a) over Cattell, in view of Rava;
6. The rejection of claims 24-27 under 35 U.S.C. § 103(a) over Cattell, in view of Ambrose and Besemer; and
7. The rejection of claim 2 under 35 U.S.C. § 103(a) over Cattell, in view of Li.

The undersigned has diligently a copy of the Cattell poster from all available sources at Agilent, including the inventors. No copy of the poster can be found. The Applicants believe that the poster no longer exists.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone James Keddle at (650) 327-3400.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10010010-1.

Respectfully submitted,

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